

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

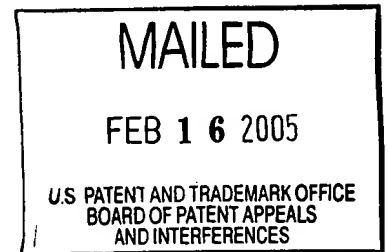
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL LAWRENCE HICKMAN and LAWRENCE KEITH STEPHENS

Appeal No. 2004-2280
Application 09/294,760

ON BRIEF



Before THOMAS, JERRY SMITH, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 2, 8, 10-14, and 18-20.

Invention

Appellants' invention relates to an apparatus, a method, and an article of manufacture for monitoring multiple electronic mail systems. The apparatus for monitoring includes a digital processor, read/write memory coupled to the digital processor, and at least one external communication channel coupled to the digital processor to permit the digital processor to communicate with a plurality of e-mail systems. The apparatus further includes a poller which generates inquiries over the communication channel, a data retriever which retrieves data concerning mail intended for a designated user, and a data handler stores and retrieves data concerning mail for the designated user. A number of external communication channels can be used with the present invention, including a local area network (LAN), a modern/telephone line system, and terminal emulators for coupling the digital processor to a larger computer system. Appellants' specification at page 3, lines 23-31.

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Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for monitoring multiple electronic mail accounts comprising:
obtaining access information for a plurality of e-mail accounts;
retrieving mail data from said plurality of e-mail accounts; and
consolidating said mail data from said plurality of e-mail accounts.

References

The references relied on by the Examiner are as follows:

Thompson et al. (Thompson)	4,935,954	Jun. 19, 1990
Cooper et al. (Cooper)	6,052,442	Apr. 18, 2000

Rejections At Issue

Claims 1, 2, 8, 10, 11, and 18-20 stand rejected under 35 U.S.C. § 103 as being obvious over Thompson.

Claims 12-14 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Thompson and Cooper.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

¹ Appellants filed an appeal brief on October 17, 2003. Appellants filed a reply brief on April 9, 2004. The Examiner mailed an Examiner's Answer on February 6, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1, 2, 8, 10-14, and 18-20 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal the claims stand or fall together in four groupings:

Claims 1, 8, 10, and 11 as Group I;

Claim 2, as Group II;

Claims 18-20 as Group III; and

Claims 12-14 as Group IV.

See page 3 of the brief. Furthermore, Appellants argue each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 4-8 of the brief and pages 1-4 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1,

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2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief.

37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the four groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;

Claim 2 as a representative claim of Group II;

Claim 18 as a representative claim of Group III; and

Claim 12 as a representative claim of Group IV.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465

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(Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1, 8, and 10-11 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1, 8, 10, and 11. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

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An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 4 of the brief, "[i]n Thompson, there is [no] teaching or suggestion of obtaining access for multiple e-mail accounts" and "Applicant's invention is simply not . . . suggested by Thompson." We find Appellants' argument unpersuasive.

We find that the Thompson patent provides more than sufficient suggestion to apply Thompson's message processing to plural message accounts where the message accounts are both e-mail accounts. At column 1, Thompson states:

There are numerous message storage systems available to a business communication customer. A typical business communication system may have a voice mail system . . .; a message center system . . .; a leave word calling message system . . .; a pink slip message system . . . or . . . a text mail system. The difficulty with these systems is that they are all independent of each other, have inconsistent storage

media and message formats and lack any consistency of message content.

Further at column 2, Thompson states:

In polling the message storage systems, the **automated message retrieval software retrieves the message** or the message header stored on the various message storage systems and **transfers same to the memory of the personal computer** for later access by the subscriber. This message retrieval includes collecting data messages from the leave word calling message storage system as well as digitally encoded voice from the voice mail system. In this fashion, **the subscriber is relieved of the task of sequentially accessing all of the message storage systems** to retrieve the messages that were transmitted to the subscriber while the subscriber was unavailable to answer the telephone station set. The subscriber can in a single message retrieval operation collect all of the messages from the personal computer memory, review all of the messages and either respond to the messages or store the messages on the personal computer memory for later review and access. The subscriber can keep a permanent file on the personal computer of the messages received without relying on one of the various message storage systems associated with the business communication system containing a record of the message so retrieved. (Emphasis added)

We find that a primary concern of Thompson is to relieve the subscriber of the task of sequentially accessing multiple message systems. We further find that a "text mail" or electronic mail (e-mail) system is included among Thompson's multiple message systems. "Electronic mail is also referred to as text mail." See Thompson at column 3, line 33.

Although we note that the Thompson patent is missing a clear indication that a subscriber may have multiple e-mail accounts per se, it plainly teaches multiple diverse types of message systems. Thus, plural versions of the same type of message system are implicit in his system. Moreover, Appellants' specification at page 1, line 29, indicates that it is known that a subscriber may have multiple e-mail accounts. Once it is known to have multiple e-mail accounts, we find that Thompson's concern to relieve the subscriber of the task of sequentially accessing multiple message systems provides a suggestion to apply the disclosed message consolidation process of Thompson to multiple e-mail accounts.

Appellants argue at page 5 of the brief that, "Thompson further does not support the possibility of multiple e-mail accounts for a user" and "the polling table . . . cannot, in any conceivable way, be configured to poll multiple e-mail accounts for a user." We find Appellants' argument unpersuasive. Appellants' personal inability to conceive how to modify the Thompson process to retrieve mail data from multiple e-mail accounts is insufficient to rebut the Examiner's **prima facie** case of obviousness.

Appellants argue at page 5 of the brief that, "[s]hould the Examiner argue that a separate routine could be written for each new e-mail account . . . [it] would be impermissible hindsight for the Examiner to make such an assertion." We find Appellants' argument unpersuasive. Thompson's figures 8-10 clearly disclose that a separate routine is written for each message account. We do not agree that it would be impermissible hindsight to extend this to a separate routine could be written for a second e-mail account.

Appellants argue at page 5 of the brief that, "[t]here is no reason why a person would have more than one e-mail address in a PBX environment" and "to do so would only create confusion." We find Appellants' argument unpersuasive. That someone might be confused is not a showing of "no reason to have multiple accounts" and is insufficient to rebut the Examiner's **prima facie** case of obviousness.

Appellants argue at page 5 of the brief that, "Thompson teaches away from the concept of multiple e-mail addresses by its nature as a PBX system and the inability of his system to support multiple e-mail accounts for a user." We find Appellants' argument unpersuasive. Appellants have provided no evidence to support either conclusion that a PBX system teaches away from the concept of multiple e-mail addresses or the inability of Thompson

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to support multiple e-mail accounts. This argument is insufficient to rebut the Examiner's **prima facie** case of obviousness.

Appellants argue at page 2 of the reply brief that, "Thompson does not consolidate." We find Appellants' argument unpersuasive. To determine whether claim 1 is obvious over the reference, we must first determine the scope of the claim.

Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "consolidate" that is different from the ordinary meaning. We find the ordinary meaning of the term "consolidate" is best found in the dictionary. We note that

the definition most suitable for "consolidate" is "to unite into one system or body".²

Appellants' position that in Thompson each type of message would be "played or displayed by its own process" is contrary to figure 13 of Thompson. Figure 13 clearly discloses one system that unites all the messages. See particularly box 1302. We find that Thompson does consolidate within the normal meaning of the term.

Finally, Appellants argue at page 2 of the reply brief that, "Thompson does not teach consolidation of one or more secondary accounts into a primary account." We find Appellants' argument unpersuasive. Appellants' argument is not commensurate in scope with claim 1. We have reviewed the claim and fail to find this limitation.

Therefore, for the reasons above we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 2 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

²The American Heritage Dictionary, Second College Edition, 1982, page 313. Copy provided to Appellant.

the art the invention as set forth in claims 2. Accordingly, we affirm.

With respect to dependent claim 2, Appellants argue at page 6 of the brief that, "Claim 2 is claiming an embodiment where there are potentially different access protocols." We find Appellants' argument unpersuasive. Appellants' argument is not commensurate in scope with claim 2. We have reviewed the claim and fail to find a limitation requiring different access protocols.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 18-20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 18-20. Accordingly, we affirm.

With respect to independent claim 18, Appellants argue at page 7 of the brief that Thompson fails to teach a plurality of electronic mail accounts. We find this argument unpersuasive as discussed above with respect to claim 1.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

**IV. Whether the Rejection of Claims 12-14 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 12-14. Accordingly, we affirm.

With respect to independent claim 12, Appellants argue at page 7 of the brief, "Cooper . . . does not work in a PBX environment" and "Cooper is directed away from a PBX environment." We find Appellants' argument unpersuasive. Cooper at column 3, lines 53-57, explicitly teaches that the environment can be a PBX system.

Appellants also argue at page 7 that "Cooper's machine . . . does not poll two or more e-mail accounts to consolidate the e-mail from such multiple accounts." We find Appellants' argument misplaced, as the Examiner has never contented that Cooper provides such teachings. Rather, the Thompson patent was relied upon for this teaching as discussed above with respect to claim 1.

Finally, Appellants argue at page 8 of the brief that the combined disclosures of Thompson and Cooper do not teach performing the claimed process on a plurality of e-mail accounts. Again we find Appellants' argument unpersuasive. As discussed above with respect to claim 1, the Thompson patent teaches or suggests performing the process on plural e-mail accounts. The Cooper patent is relied on to teach that an external e-mail account is a known type of e-mail account.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

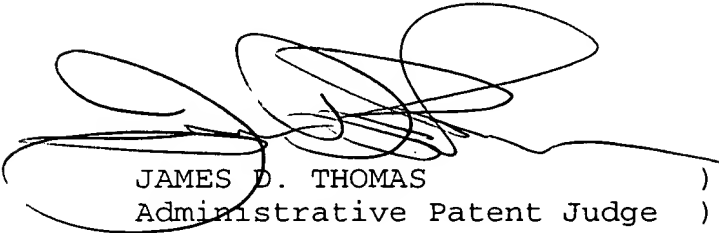
Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1, 2, 8, 10-14, and 18-20.

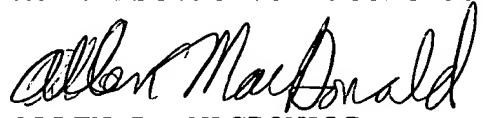
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No time period for taking any subsequent action in
connection with this appeal may be extended under
37 CFR § 1.136(a)(1)(iv).

AFFIRMED


JAMES D. THOMAS)
Administrative Patent Judge)


JERRY SMITH)
Administrative Patent Judge)


ALLEN R. MACDONALD)
Administrative Patent Judge)

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